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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,245	08/31/2000	David A. Cordray	AUS9-2000-0403-US1	4517

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EXAMINER

FLYNN, KIMBERLY D

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/653,245

Applicant(s)

CORDRAY ET AL.

Examiner

Kimberly D Flynn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4, 10-13, 15, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moon et al. (U.S. Patent No. 6,138,146 hereinafter, Moon) in view of Klein et al. (U.S. Patent No. 6,496,853 hereinafter Klein).

In considering claims 1, 4, 11-12, 15, and 22, Moon discloses a system and method for processing an electronic mail message, the method comprising:

determining whether the electronic mail message for a recipient is to be forwarded to another address associated with the recipient (col. 7, lines 22-26);

While Moon discloses the system substantially as claimed, Moon does not expressly disclose the step of including an indicator identifying the electronic mail message as to be forwarded if the electronic mail message is to be forwarded to another address associated with the recipient. Nonetheless, using indicators to when one message is a response to another message (e.g. a reply to or a forwarding of) another message is well known as evidenced by Klein.

In the same field of endeavor, Klein discloses a system for managing related electronic messages that includes a message thread, which is a group of messages that are related to one another either by reply or forwarding. Klein also discloses wherein

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messages in the same message thread, share various common message information along with relation indicators such as "RE", which indicates a reply message, or "FW", which indicates a forwarded message (See Klein col. 1, lines 35-45). It is common of most e-mail clients to include such relation indicators that identify what type of e-mail message is being received. Thus, given the teachings of Klein it would have been obvious to modify the system as disclosed by Moon to include the relation indicator taught by Klein in order to provide to the recipient descriptive e-mail, that if forwarded; is indicated as such. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by Moon.

In considering claims 2 and 13, Moon discloses the method further comprising: sending the message after including the indicator (col. 7, lines 32-41).

In considering claims 10, 21, and 23 Moon discloses a system and method for forwarding an electronic mail message comprising:

receiving a signal to forward the electronic mail message to another address (col. 6, lines 34-45);

While Moon discloses the system substantially as claimed, Moon does not expressly disclose the step of including an indicator identifying the electronic mail message as to be forwarded if the electronic mail message is to be forwarded to another address associated with the recipient. Nonetheless, using indicators to when one message is a response to another message (e.g. a reply to or a forwarding of) another message is well known as evidenced by Klein.

In the same field of endeavor, Klein discloses a system for managing related electronic messages that includes a message thread, which is a group of messages that are

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related to one another either by reply or forwarding. Klein also discloses wherein messages in the same message thread, share various common message information along with relation indicators such as "RE", which indicates a reply message, or "FW", which indicates a forwarded message (See Klein col. 1, lines 35-45). It is common of most e-mail clients to include such relation indicators that identify what type of e-mail message is being received. Thus, given the teachings of Klein it would have been obvious to modify the system as disclosed by Moon to include the relation indicator taught by Klein in order to provide to the recipient descriptive e-mail, that if forwarded; is indicated as such. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by Moon.

3. Claims 3,5-9, 14,16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moon in view of Berkowitz (U.S. Patent No. 6,088,720 hereinafter, Berkowitz) in further view of Fuisz et al. (U.S. Patent No. 6,389,445 hereinafter Fuisz).

In considering claims 3,5-7, 9, 14,16-18, and 20, while Moon discloses the system substantially as claimed Moon does not expressly disclose wherein the indicator can be represented by one of the following: text in the body of the electronic message, an audio indicator, a presentation of a wave file, a graphical indicator, or an advertisement.

However, while including a forwarding indicator is well known, the type or style of forwarding indicator is merely a design choice. Accordingly, it is well known for e-mail systems to have the capability to incorporate various attachments to e-mail such as text, sound clips, WAV files, video clips, and graphics as evidenced by Berkowitz (col. 2, lines 20-24). While most e-mail clients can accommodate the receipt of any type of file, some e-mail clients are limited to specific types.

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It would have been obvious to a person having ordinary skill in the art to recognize the desirability and advantages of modifying the system as disclosed by Moon to include indicators of different forms in order accommodate the specifications of the receivers' e-mail client. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by Moon.

In considering claims 8 and 19, while Moon discloses the system substantially as claimed Moon does not expressly disclose wherein a billing database is updated for including the indicator for the recipient. Nonetheless, electronic billing that bills users for services such as forwarding or bouncing mail, sending mail etc. is well known in the art. In similar art, Fuisz discloses a system for bouncing electronic messages, which includes an electronic billing system attached to the bounce service that stores user's identification and credit card information and bills the user for bounced e-mail (col. 8, lines 45-55).

It would have been obvious to a person having ordinary skill in the art to recognize the desirability and advantages of modifying the system as disclosed by Moon to include the electronic billing system taught by Fuisz in order to provide efficient accounting of charges to users for services. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by Moon.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609. The examiner can normally be reached on M-F 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238, for After Final communications


(703) 746-7239, for Official communications

(703) 746-7240, for Non-Official/Drafts.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Kimberly D Flynn  
Examiner  
Art Unit 2153

KF  
March 22, 2003

  
GLENTON B. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100